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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,720	04/05/2001	Charles C. Packham	11223-002002	3943

7590 12/03/2001  
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225 Franklin Street  
Boston, MA 02110-2804

EXAMINER

GOODMAN, CHARLES

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 12/03/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/826,720

Applicant(s)

PACKHAM ET AL.

Examiner

Charles Goodman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 22-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 22-40 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 22-23, drawn to a method of producing an electroformed shaving cutter and stainless steel substrate.
  - II. Claims 22 and 24, drawn to a method of producing an electroformed shaving cutter and plastics material substrate.
  - III. Claims 22, 25, and 26, drawn to a method of producing an electroformed shaving cutter and non-elongate apertures.
  - IV. Claims 22, 27, and 28, drawn to a method of producing an electroformed shaving cutter and elongate apertures.
  - V. Claims 22 and 29, drawn to a method of producing an electroformed shaving cutter and relief pattern metallic layer.
  - VI. Claims 22 and 30, drawn to a method of producing an electroformed shaving cutter and a ductile mask.
  - VII. Claims 22 and 31, drawn to a method of producing an electroformed shaving cutter and steps of separating the metallic layer.
  - VIII. Claims 22 and 38, drawn to a method of producing an electroformed shaving cutter and a non-zero Gaussian curvature surface.
  - IX. Claims 22 and 39, drawn to a method of producing an electroformed shaving cutter and copper mask.

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- X. Claims 32 and 33, drawn to a method of manufacturing a three-dimensional electroforming mask and an electrically conductive substrate.
- XI. Claims 32, 34-37, and 40, drawn to a method of manufacturing a three-dimensional electroforming mask and an electrically insulating substrate.

The inventions are distinct, each from the other because of the following reasons:

- 2. Inventions I-IX and X-XI are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it does not require etching using a laser for patentability. The subcombination has separate utility such as manufacturing a three-dimensional electroforming mask not used in producing a shaving cutter.

- 3. Group I is distinct from Groups II-IX because it does not require the particulars of Groups II-IX. For example, Group I does not require the plastics material substrate; the non-elongate apertures; the elongate apertures; the relief patter metallic layer; the ductile mask; the particular steps of separating the metallic layer; the non-zero Gaussian curvature surface; and the copper mask of Groups II-IX for patentability as evidenced by the lack thereof in Group I.

- 4. Group II is distinct from Groups I and III-IX because it does not require the particulars of Groups I and III-IX. For example, Group II does not require the stainless steel substrate; the non-elongate apertures; the elongate apertures; the relief patter

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metallic layer; the ductile mask; the particular steps of separating the metallic layer; the non-zero Gaussian curvature surface; and the copper mask of Groups I and III-IX for patentability as evidenced by the lack thereof in Group II.

5. Group III is distinct from Groups I-II and IV-IX because it does not require the particulars of Groups I-II and IV-IX. For example, Group III does not require the stainless steel substrate; the plastics material substrate; the elongate apertures; the relief patter metallic layer; the ductile mask; the particular steps of separating the metallic layer; the non-zero Gaussian curvature surface; and the copper mask of Groups I-II and IV-IX for patentability as evidenced by the lack thereof in Group III.

6. Group IV is distinct from Groups I-III and V-IX because it does not require the particulars of Groups I-III and V-IX. For example, Group IV does not require the stainless steel substrate; the plastics material substrate; the non-elongate apertures; the relief patter metallic layer; the ductile mask; the particular steps of separating the metallic layer; the non-zero Gaussian curvature surface; and the copper mask of Groups I-III and IV-IX for patentability as evidenced by the lack thereof in Group IV.

7. Group V is distinct from Groups I-IV and VI-IX because it does not require the particulars of Groups I-IV and VI-IX. For example, Group V does not require the stainless steel substrate; the plastics material substrate; the non-elongate apertures; the elongate apertures; the ductile mask; the particular steps of separating the metallic layer; the non-zero Gaussian curvature surface; and the copper mask of Groups I-IV and VI-IX for patentability as evidenced by the lack thereof in Group V.

8. Group VI is distinct from Groups I-V and VII-IX because it does not require the particulars of Groups I-V and VII-IX. For example, Group VI does not require the

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stainless steel substrate; the plastics material substrate; the non-elongate apertures; the elongate apertures; the relief patter metallic layer; the particular steps of separating the metallic layer; the non-zero Gaussian curvature surface; and the copper mask of Groups I-V and VII-IX for patentability as evidenced by the lack thereof in Group VI.

9. Group VII is distinct from Groups I-VI and VIII-IX because it does not require the particulars of Groups I-VI and VIII-IX. For example, Group VII does not require the stainless steel substrate; the plastics material substrate; the non-elongate apertures; the elongate apertures; the relief patter metallic layer; the ductile mask; the non-zero Gaussian curvature surface; and the copper mask of Groups I-VI and VIII-IX for patentability as evidenced by the lack thereof in Group VII.

10. Group VIII is distinct from Groups I-VII and IX because it does not require the particulars of Groups I-VII and IX. For example, Group VIII does not require the stainless steel substrate; the plastics material substrate; the non-elongate apertures; the elongate apertures; the relief patter metallic layer; the ductile mask; the particular steps of separating the metallic layer; and the copper mask of Groups I-VII and IX for patentability as evidenced by the lack thereof in Group VIII.

11. Group IX is distinct from Groups I-VIII because it does not require the particulars of Groups I-VIII. For example, Group IX does not require the stainless steel substrate; the plastics material substrate; the non-elongate apertures; the elongate apertures; the relief patter metallic layer; the ductile mask; the particular steps of separating the metallic layer; and non-zero Gaussian curvature surface of Groups I-VIII for patentability as evidenced by the lack thereof in Group IX.

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12. Group X is distinct from Group XI because it does not require the particulars of Group XI. For example, Group X does not require the electrically insulating substrate of Group XI for patentability as evidenced by the lack thereof in Group X.

13. Group XI is distinct from Group X because it does not require the particulars of Group X. For example, Group XI does not require the electrically conductive substrate of Group X for patentability as evidenced by the lack thereof in Group XI.

14. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

15. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

16. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (703) 308-0501. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.


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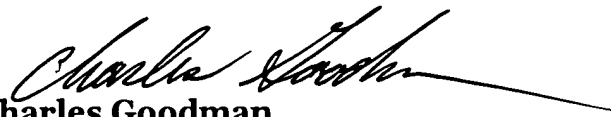
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap, can be reached on (703) 308-1082. The fax phone number for this Group is (703) 305-3579.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**allan.shoap@uspto.gov**].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

cg   
November 19, 2001

  
Charles Goodman  
Patent Examiner  
AU 3724



Attachment for PTO-948 (Rev. 03/01, or earlier)  
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a)

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.